

REMARKS/ARGUMENTS

Claims 1-11 are currently pending in this application. In view of the following remarks, favorable consideration and allowance of the application is respectfully requested.

35 U.S.C. §103 Rejections

Claims, claims 1, 2, 4-6, 8, 10, and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over US 6,348,064 to Kanner (Kanner) in view of US 5,342,396 to Cook (Cook). Claim 3 is rejected as unpatentable over Kanner in view of Cook, and in further view of US 4,610,251 to Kumar. Claim 7 is rejected as being unpatentable over Kanner in view of Cook, and in further view of US 4,653,637 to Schreiber. Claim 9 is rejected as being unpatentable over Kanner in view of Cook, in further view of US 7,112,214 to Peterson. The rejections under 35 U.S.C. §103(a) are traversed. None of the combinations of prior art include devices with legs having bistable snap-acting spring tips.

Obviousness is a question of law, based on the factual inquiries of 1) determining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The law requires that, for a patent claim to be held obvious over the prior art, it is not sufficient to merely cite piecemeal elements of the claim in separate prior art references. Rather, these must be some reasonable basis for a person of ordinary skill in the art to have combined those elements in the claimed manner with a predictability of success that the combination would work in the intended manner. This predictability of success is necessary for a finding of obviousness. In this regard, the United States Supreme Court has stated in *KSR International Co. v. Teleflex Inc.*, 550 U.S. at 1, 82 USPQ2d at 1391 (2007) that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a *predictable* variation, §103 likely bars its patentability.

Id. at 5, 82 USPQ2d at 1396 (emphasis added). Furthermore, where an independent claim is non-obvious, any claim depending therefrom is also non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). *See*, MPEP 2143.03.

Applicants respectfully contend that the combinations of art cited in the Office Action do not make the current invention obvious. Among other things, none of the references cited in the office action (either alone or in combination with each other) disclose, teach, or suggest methods of altering the shape of heart valves by using devices having bistable snap-acting spring tips. While the devices disclosed in the art may have bistable tips, none of the devices have snap-acting tips as disclosed by applicants.

Referring to the rejection of Applicants' independent claim 1, none of the art cited in the Office Action makes the device claimed in that claim obvious. Kanner does not disclose a device having legs wherein each leg further includes a bistable snap-acting spring tip. Instead, the devices of Kanner have tips with a permanent hook shape such that the tips secure tissue when the legs of the devices are moved to a treatment state. Cook also does not disclose devices having bistable snap-acting tips. Instead, the tips of the staples disclosed require an "anvil" or other resistive devices to cause bending in the legs of the staples disclosed therein.

The bistable tips of Applicants' legs each have two stable states and the transition between the two states is caused by application of an axial force to the device. As described in paragraph 0031 of the current application:

When axial force is applied to body 111, snap-acting spring tips 116, with spicules 117, are pressed against the surface of the valve annulus and begin to pierce into the tissue of the annulus. At a certain threshold force, snap-acting spring tips 116 will transform "over-center" from their deployed state generally perpendicular to the plane of the valve annulus into their treatment state wherein they are directed generally radially inward toward the longitudinal axis of body 111.

None of the art cited in the office action includes the snap-acting tips as claimed in Claim 1 of the current application. Thus because claim 1 is not obvious and all of the other claims depend from claim 1, they are not obvious. Applicants, therefore,

respectfully request the withdrawal of the rejection of their claims under 35 U.S.C. § 103(a).

CONCLUSION

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5484.

Respectfully submitted,

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